

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-47 are pending in this application. Claims 1, 3, 4, 11, 17, 22-27, 31, 33-38 and 43-45 are amended and Claim 47 is added by the present response. Support for amendments to the claims can be found in the originally filed disclosure, at least in Figure 3 and corresponding disclosure. Thus, no new matter is added.

In the outstanding Office Action, Claims 1-16 were rejected under 35 U.S.C. §112, second paragraph as indefinite; Claims 1-24, 26-33, 36-42 and 46 were rejected under 35 U.S.C. §103(a) as unpatentable over Lockwood (U.S. Pat. No. 4,567,359) in view of Ryan et al. (U.S. Pat. Pub. No. 2003/0187768, herein “Ryan”); and Claims 25, 35 and 43-45 were rejected under 35 U.S.C. §103(a) as unpatentable over Lockwood and Ryan in view of Maus et al. (U.S. Pat. No. 7,092,891, herein “Maus”).

With respect to the rejection of Claims 1-16 under 35 U.S.C. §112, second paragraph, as indefinite, Applicants respectfully traverse this rejection as improper. Specifically, Applicants note that the outstanding Action has appeared to misapply the applicable law in the present case. For example, although a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite, method steps which reference an apparatus are not improper. MPEP §2173.05(p) states “a claim to a device, apparatus, manufacture, or composition of matter *may contain a reference* to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process” (emphasis added).

Further, as was noted in *PXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005) the test for determining whether the claim is a “mixed type” claim is whether the claim can be read either as a system claim or method claim. In the present case, one skilled in the art would clearly interpret Claim 1 as a method claim even though it includes a reference to an “automated underwriting system” as claim clearly is not an apparatus claim.

Moreover, further evidence of that process claims may permissibly reference an apparatus is found in *In re Bilski* in which the court required, in one prong of the test, that the process claim be tied to a statutory machine. In other words, the process claim was required by the court to reference an apparatus. Thus, Applicants respectfully submit that Claims 1-16 are not indefinite under 35 U.S.C. §112, second paragraph.

Accordingly, Applicants respectfully request that the rejection of Claims 1-16 under 35 U.S.C. §112, second paragraph be withdrawn.

Addressing now the rejection of Claims 1-24, 26-33, 36-42 and 46 under 35 U.S.C. §103(a) as unpatentable over Lockwood and Ryan, Applicants respectfully traverse this rejection.

Amended Claim 31 recites, in part,

- a. information collecting apparatus comprising a display, an automated life insurance application which can be viewed by the applicant using the display, and an input device for use by the applicant in entering self-reported information;
- b. one or more medical measuring stations for collecting objective information from the applicant by measuring physiological aspects of the applicant;
- c. a processor for hosting a life insurance underwriting program;
- d. means for inputting information from the apparatus for collecting self-reported information and the objective information from said one or more medical measuring stations to the processor for use by the life insurance underwriting program;
- e. means for displaying to the applicant at least one of a preliminary quote based only upon the self-reported

information and a final quote based upon both the self-reported information and the objective information; and

f. an input device for use by the applicant in acknowledging at least one of the preliminary and final quotes.

Claims 1, 17 and 38 recite similar features with regard to measuring physiological aspects of the applicant.

Lockwood describes a system for automatically dispensing information, goods and services to a customer. Further, Lockwood describes a system that provides insurance quotes from several companies based on information entered by a customer via a touch pad 13 displayed on a monitor screen.

However, as is acknowledged by the outstanding Office Action on page 9, Lockwood does not describe or suggest collecting objective information relating to the insurable risk from the applicant. Furthermore, Applicants note that Lockwood does not describe or suggest one or more medical measuring stations for collecting objective information from the applicant by measuring physiological aspects of the applicant, as is recited in Claim 31.

Nevertheless, the outstanding Action cites Ryan as curing the deficiencies of Lockwood with regard to the claimed invention.

Ryan describes an internet based insurance company. Further, Ryan describes that a third party administrator (TPA) can be used in conjunction with the internet based insurance company. The TPA can be used to provide the internet based company with a review of risks which are not approved by the underwriting system. Further, with regard to these risks, the TPA can order medical, credit and driving reports for those prospective policyholders which do not meet the underwriters' criteria.¹

However, Ryan never describes or suggests a system having one or more medical measuring stations for collecting objective information *from the applicant by measuring physiological aspects of the applicant*.

¹ See Ryan paragraph 773.

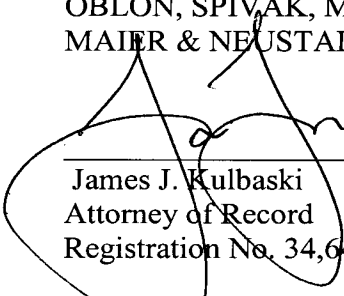
Thus, while the claimed invention is able to quickly and efficiently provide an applicant with an insurance quote using a system which is able to collect both self-reported information and objective information, systems such as the one described in Ryan require long and drawn out underwriting procedures which are slow and inconvenient to the applicant.

Thus, Applicants respectfully submit that Claim 31 and similarly Claims 1, 17 and 38, and claims depending respectively therefrom, patentably distinguish over the combination of Lockwood and Ryan.

Consequently, in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

James Love
Registration No. 58,421

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)